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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/675,928	09/29/2003	Bruce A. Bennett	20375-043100	2373
20350	7590	06/28/2005	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			NOLAND, KENNETH W	
			ART UNIT	PAPER NUMBER
			3653	

DATE MAILED: 06/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/675,928

Applicant(s)

BENNETT ET AL.

Examiner

Kenneth W. Noland

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 7-18 is/are rejected.
- 7) ☒ Claim(s) 4-6 and 19 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>01-26-04</u> . | 6) <input type="checkbox"/> Other: ____  |

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1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1,2,10,14 and 18 are rejected under 35 U.S.C. 102(\*b\*\*) as being \*anticipated\*\* by \*York et al. York et al discloses the process and the method to reorient mail where, when the processor is in the first direction (position) C, the mail is 'flipped' from an upside-down to a right side- up orientation (see col 12, lines 24-34, and col 2,lines 20-23) ,and is moved downstream therefrom.. Note in col 13,lines14-17, the use of the sensor 96 to control the arm 99 of the reorientation device. When the processor is in a second direction (position) D , the mail is guided in the direction D without reorientating the mail, and is moved downstream therefrom ( see again col 12, lines 33-35). . \*\*.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over \*York et al in view of Stevens et al(5,464,099). To provide York et al's processor has a sensor for the first or the second directions (positions) would be obvious in view of the teachings of Stevens et al's use of the sensors which monitors the status of the objects along various

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transport paths (see col 57, lines 56-61) , so as to effect improved monitoring of the mail along various paths of the processor.

\*\*

5. Claims 7, 11 and 15 are\*\*\* rejected under 35 U.S.C. 103(a) as being unpatentable over \*York et al in view\*of Hill et al.. To provide that York et al's mail items would comprise of a card carrier for a card\*, would be obvious in view of the teachings of Hill et al use of the mail processor handling card carriers, noted in the abstract, so as to effect the handling of a variety of mail items.

6. Claims 8, 9, 12, 13, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over \*York et al in view of Stevens et al(5,460,273). To provide that York et al's mail items would comprise folded documents would be obvious in view of the teachings of Stevens et al's use of the folded documents (see col 10, lines 56-59) so as to effect the handling of a variety of mail items. Further, the specific use of folded documents having folds to provide three or four areas would be obvious as a mere choice to provide any desired number of folds to produce any number of areas for the folded document, and, therefore, this expedience is not afforded any patentable weight.

7. Claims 4, 5, 6, 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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*Kenneth W. Noland 6/22/2005*  
**KENNETH W. NOLAND**  
**PRIMARY EXAMINER**